

**REMARKS**

Claim 58 is pending. New Claims 59-77 are hereby submitted for consideration by the Examiner. Applicants suggest the Examiner may find support for the new claims as follows:

Claims 59, 64, 69 & 74 - pg 47 ln 23-24

Claims 60, 65, 70 & 75- pg 47 ln 24-25

Claims 61, 66 71 & 76- pg 44 ln 22- pg 45 ln 29

Claims 62, 67 72 & 77- pg 45 ln 30 - pg 47 ln 9

Claims 63, 68 & 73- pp 6, 7, 9 & 22

The priority information has been amended per the Examiner's request (Office Action pg 2 Item 2).

The Examiner provided a number of rejections in the Office Action Mailed March 27, 2002 and we list them here in the order in which they are addressed:

- I. Claim 58 is rejected under 35 U.S.C. § 112 ¶ 1 because the specification allegedly does not reasonably provide enablement for the scope of agents recited.
- II. Claim 58 is rejected under 35 U.S.C. § 112 ¶ 1 because the claim allegedly is not described in the specification in such a way as to reasonably convey that the Applicant had possession of the invention.
- III. Claim 58 is rejected under 35 U.S.C. § 112 ¶ 2 as allegedly being indefinite due to the lack of definition of an acronym.
- IV. Claim 58 is rejected under 35 U.S.C. § 102(a) or (b) as allegedly being anticipated by Alphey et al. or by Nangaku et al.

Applicants' specification clearly explains the acronym, TL- $\gamma$ , appearing in Claim 58. Applicants therefore, do not believe a redefinition in the claims is necessary. Nonetheless, without acquiescing to the Examiners' argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 58 by deleting the term TL- $\gamma$  and replacing it with SEQ ID NO: 1. Accordingly, Applicants respectfully request the Examiner to withdraw this rejection.

#### **IV. Claim 58 Is Not Anticipated**

As the Examiner is well aware, a single reference must disclose **each limitation** of a claim in order for that reference to anticipate the claim. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). This criterion is not met with either of the references cited by the Examiner.

##### **A. Claim 58 Is Not Anticipated By Alphey et al.**

The Examiner rejects Claim 58 on the basis that it is anticipated by Alphey et al. Applicants disagree. The method of Alphey et al. only demonstrates that a radiolabeled KLP38B will bind to PP1 but does not disclose the specific sequences involved in the binding interaction between PP1 87B and KLP38B. Importantly, Alphey et al. does NOT disclose SEQ ID NO: 1 which is an express limitation of Claim 58.<sup>1</sup> Applicants, therefore, respectfully request the Examiner to withdraw this rejection.

##### **B. Claim 58 Is Not Anticipated By Nangaku et al.**

The Examiner asserts that Claim 58 is anticipated under 35 U.S.C. § 102(b) by Nangaku et al. Applicants disagree. The Examiner apparently relies on the antibody binding assay disclosed in Nangaku et al. The Examiner concludes that "... the unc-104 family and KIF1B (see specification 2) are significantly related to TL- $\gamma$ , it would appear that the identification of agents which bind to KIF1B will inherently bind to TL- $\gamma$  ..." *Office Action* pg 9. However, it is important to note that Nangaku et al. does NOT disclose SEQ ID NO: 1

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<sup>1</sup> Applicants also note that Alphey et al. does not disclose the specific sequences recited in new independent claims 63, 68 and 73.

**I. Claim 58 Is Enabled Under 35 U.S.C. § 112, ¶ 1**

The Examiner rejects Claim 58 on the basis that "... the specification ... does not reasonably provide enablement for agents which bind to TL- $\gamma$  or portions thereof which encompasses any and all biologically functional equivalents and sequences unknown to the inventor". *Office Action pg 3 ¶ 4*. Applicants disagree. The Examiner is reminded that an application need not provide an Example of every possible embodiment of an invention. Applicants believe that sufficient data is presented to support Claim 58 as originally filed. Nonetheless, without acquiescing to the Examiners' argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 58 to recite the TL- $\gamma$  sequence (i.e., SEQ ID NO: 1). Support for the recited portions in new Claims 63-77 from amino acids 1 to 357, 443 to 601, and 602 to 784 is found in the specification at pages 6,7, 9 and 22. Since the Examiner admitted that these portions are also enabled (Office Action page 3 Item 4, first sentence) these claims are enabled. The Applicants respectfully request the Examiner to withdraw this rejection.

**II. Claim 58 Is Possessed By The Inventors Under 35 U.S.C. § 112 ¶ 1**

The Examiner rejects Claim 58 for "... containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention." *Office Action pg 4 ¶ 5*. The Applicants disagree and reiterate the argument made immediately above. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 58 to recite SEQ ID NO: 1 instead of TL- $\gamma$ . Accordingly, Applicants respectfully request the Examiner to withdraw this rejection.

**III. Claim 58 Is Definite Under 35 U.S.C. § 112 ¶ 2 And Has A Defined Acronym**

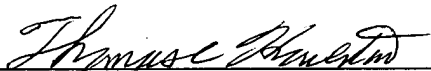
The Examiner rejects Claim 58 for "... being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." *Office Action pg 7, ¶ 8*. Applicants disagree. Applicants respectfully remind the Examiner that the claims of an invention are interpreted according to the explanations within the specification.

which is recited in Claim 58. Accordingly, it cannot anticipate.<sup>2</sup> Applicants, therefore, respectfully request the Examiner to withdraw this rejection.

**CONCLUSION**

The Applicants believe that the arguments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn. Should the Examiner find that the amended claims are not allowable, the Applicant encourages the Examiner to call Maha Hamdan collect at 510.237.8552 to arrange a telephone interview prior to drafting another Office Action.

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<sup>2</sup> Applicants also note that Nangaku et al. does not disclose the specific sequences recited in new independent claims 63, 68 and 73.



APPENDIX I  
MARKED-UP VERSION OF REWRITTEN CLAIMS  
PURSUANT TO 37 CFR § 1.121 (c)(1)(ii)

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58. (Once amended) A method for identifying [agents] an agent which binds to SEQ ID NO:1, [TL- $\gamma$  or portions thereof, wherein a portion refers to the stalk, motor, or tail domain of TL- $\gamma$ ,] comprising:
- (a) adding a candidate agent to an amino acid sequence comprising SEQ ID NO:1; [TL- $\gamma$  or a portion thereof] and
  - (b) [identifying] detecting binding of said agent to said SEQ ID NO:1, thereby identifying said agent as binding to SEQ ID NO:1 [any agents which bind thereto].